



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/561,416

05/26/2006

Masaaki Yoshikawa

P28976

6545

52123 7590 10/27/2010
GREENBLUM & BERNSTEIN, P.L.C.
1950 ROLAND CLARKE PLACE
RESTON, VA 20191

EXAMINER

KIM, STEVEN S

ART UNIT

PAPER NUMBER

3685

NOTIFICATION DATE

DELIVERY MODE

10/27/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

gbpatent@gbpatent.com
pto@gbpatent.com

Office Action Summary	Application No. 10/561,416	Applicant(s) YOSHIKAWA, MASA AKI	
	Examiner STEVEN KIM	Art Unit 3685	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 August 2010.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-51 is/are pending in the application.
- 4a) Of the above claim(s) 44-51 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/24/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This office action is in response to the Applicant's communication on August 9, 2010.

Restriction/Election Acknowledgement

2. The Applicant's election on Group I, claims 35-43, of the restriction requirement dated 7/09/2010, with traverse, in the reply on 8/09/2010 is acknowledged. The Applicant's traverse has been considered by the Examiner. Examiner, however, respectfully maintains the restrictions based on the reasons outlined in the restriction requirement dated 7/09/2010. Examiner also submits that the viewing control apparatus claimed in 35 and the viewing control apparatus in claim 44 are different in that the viewing control apparatus in claim 44 recites an updater.
3. Claims 44-51 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group(s).

Response to Arguments

4. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

Status of Claims

5. Claims 1-34 have been canceled.
6. Claims 35-51 have been newly added since the first office action dated 8/14/2009 and are now pending.
7. Claims 44-51 are withdrawn.
8. Claims 35-43 have been examined.

Information Disclosure Statement

9. The information disclosure statement filed 3/24/2005 is being considered by the Examiner.

Claim Objections

10. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: “common information” (claim 35, 37, and 43), “extractor” (claims 35, 37, 38, 40, and 43), “decoder” (claim 35, 36, and 43), “searches”/“searched”/“searching”/“searcher” (claims 35, 37, and 43), “time decider” (claim 39 and 41), “decider” (claim 43).
11. The Examiner notes that the USPTO’s Board of Patent Appeal and Interferences (“Board”) has recently recognized the lack of antecedent basis of claim terms in the

Art Unit: 3685

original specification as a "significant problem." See 73 Fed. Reg. 32944 (June 10, 2008) (noting that "[o]ne significant problem faced by the Board under Rule 41.37(c)(1)(v) occurs when the language of a claim does not have direct antecedent language in the specification.").

12. Additionally, the Examiner notes that patent examiners have no authority to waive the provisions of a rule. See *In re Goodman*, 3 USPQ2d 1866, 1871 (ComrPats 1987) noting the examiners have no authority to waive 37 C.F.R. §1.111(b).

13. Because the lack of antecedent basis is currently recognized by the USPTO as a significant problem and because the Examiner has no authority to waive the provisions of a rule, correction of the noted objections to the specification under 37 C.F.R. § 1.75(d)(1) is required.

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

15. Claims 35-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

16. Per claim 35-42, the claims are directed to software per se as the claims recite extractor, and decoder. Software is defined by Computer Dictionary, 3rd Edition, Microsoft Press, Redmond, WA, 1997, as "Computer programs; instructions that make hardware work". According to MPEP 2106 II IV, however, there are four categories of

Art Unit: 3685

invention: process, machine, article of manufacture or composition of matter. Therefore, as "software" is neither a category of invention nor a subset of one of the categories it does not represent patent eligible subject matter (See *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)). Additionally, in reference to recited "storage", while the term "storage" is disclosed in the specification, the specification does not illuminate the storage as device or apparatus. Hence, storage is neither a category of invention nor a subset of one of the categories it does not represent patent eligible subject matter (See *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007)).

17. Similarly, claim 43 are directed to software per se, e.g. a searcher, decider, extractor, and a decoder and are rejected similarly.

18. Furthermore, based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, one factors to consider when determining if a claim recites a §101 patent eligible process is whether the claimed process (1) is tied to a particular machine or apparatus (machine implemented); or (2) particularly transform a particular article to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *Bilski v. Kappos*, 95 USPQ2d 1001 (U.S. 2010).

19. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. To meet prong (1), the method step

Art Unit: 3685

should positively recite a particular machine or apparatus to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claims 43 fails prong (1) because the recited steps do not positively recite a particular machine or apparatus to which the steps are tied. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

Claim Rejections - 35 USC § 112, 1st Paragraph

20. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

21. Claims 35-43 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Art Unit: 3685

22. Claim 35-43 are claims that have been newly added after the first office action, dated 8/14/2009. Claims 35-43 are replete with subject matter which was not described in the original specification, too numerous to mention. For example, claim 35 recites “a storage that stores the contract information associated with the advertisement upon viewing of the advertisement; an extractor that, upon acquiring of common information, searches the identification information included in the contract information stored in said storage, for a same identification information as the identification information included in the acquired common information, determines whether or not the viewing of the contents associated with the searched identification information is allowed, based on the date information included in the contract information including the searched identification information, and, upon a determination that the viewing is allowed, extracts the first key data from the acquired common information; and a decoder that decodes the encrypted contents using the extracted first key data”. While the Examiner was able to find support for some of the recited elements, e.g. storage, in the original written disclosure, the Examiner was not able to find most of the claimed elements/features and specific embodiments in the original specification. Examiner advises the Applicant to amend the claims to remove the new subject matters that are not supported by the original disclosure or specifically point out where in the original disclosure discloses the newly added elements/feature and specific embodiments.

Claim Rejections - 35 USC § 112, 2nd Paragraph

23. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

24. Claims 35-43 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

25. Per claim 35-42, the claims are directed towards an apparatus, e.g. "viewing control apparatus" (claim 35). The claims, however, are also directed toward a process, see at least claim 35 that recites "stores ... upon viewing", "upon acquiring ... searches ... determines ... upon a determination is made ... extracts", etc. It has been held a single claim which purports to be both a product or machine and a process is ambiguous and is properly rejected under 35 USC 112, second paragraph, for failing to particularly point out and distinctly claim the invention (*Ex Parte Lyell*, 17 LISPQ2d 1548 (B.P.A.I. 1990)).

26. Furthermore, the scope is unclear. Specifically, the claims are directed to an apparatus. The claims, however, are directed to an extractor and a decoder which are read with broadest reasonable interpretation (during patent examination the pending claims must be interpreted as broadly as their terms reasonably allow, *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989)), to be a software or logic, hence lacking structural component and resulting scope that do not commensurate.

27. Additionally, the recited "based on the date information included in the contract information *including the searched identification information*" is unclear resulting unclear

Art Unit: 3685

scope. An essential purpose of patent examination is to fashion claims that are precise, clear, correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. See *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

28. Per claim 37, the recited “said extractor decodes ... by the second key data” is unclear resulting unclear scope. Additionally, the claim recites “the contract information or the common information is encrypted **by** the second key data”. Is the second key data encrypting the information?

29. Similarly, the recited “encrypted by second key ... encrypted by third key”, “the third key data is encrypted by the second key data”, “said extractor extracts ... by decoding ... by the second key data”, “said storage decodes ... by the third key data and the second key data” in claim 38 are unclear resulting unclear scope.

30. Similarly, claim 40 recites “encrypted by ... key data” and is rejected similarly.

31. Per claim 43, the scope of the claim is unclear due to unclear claim language. Specifically, the recited “searching ... for a same identification information as the identification information included in the acquired common information from the identification information included in the contract information stored in the storage” is unclear. Furthermore, the recited “based on the date information included in the contract information *including the searched identification information*” is unclear. An essential purpose of patent examination is to fashion claims that are precise, clear,

Art Unit: 3685

correct, and unambiguous. Only in this way can uncertainties of claim scope be removed. See *In re Zletz*, 13 USPQ2d 1320 (Fed. Cir. 1989).

32. Additionally, the claim suggest searching for a same identification information and determining whether the viewing is allowed based on date information included in the contract information. The claim omits the step of retrieving or extracting date information from the contract information; resulting being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01.

Claim Rejections - 35 USC § 103

33. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

34. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,892,900 ("Ginter") in view of US Patent Application 2003/0172376 ("Coffin"). US Patent No. 6,216,112 ("Fuller").

35. Per claim 35, Ginter discloses a viewing control apparatus comprising:

- a storage that stores the contract information associated with the advertisement (see Fig. 7; Fig. 16; col. 10, lines 47-55; col./line 10/64-11/16; col. 18, lines 56-64; col. 19-58; col. 111, 25-41; col. 131, lines 7-27; col. 152,

Art Unit: 3685

- lines 10-16; col./line 272/62-273/39; col. 283, lines 52-53; col. 312, lines 31-32);
- an extractor (see Fig. 7, ROS 602; Fig. 8, ROS 602; col. 18, lines 22-38) that, upon acquiring of information, searches the identification information included in the contract information stored in said storage, for a same identification information as the identification information included in the acquired information (see col. 23, lines 15-21; col. 68, lines 35-42; col. 110, lines 20-25; col. 111, 25-41; col. 131, lines 7-27; col. 167, lines 11-33), determines whether or not the viewing of the contents associated with the searched identification information is allowed, based on the date information included in the contract information including the searched identification information (see col. 49, lines 7-10; col./line 133/10-134/14; col./line 139/66-140/9; col. 155, lines 37-51; col. 169, lines 61-67; col./line 272/62-273/39), and, upon a determination that the viewing is allowed, extracts the first key data from the acquired information (see col. 134, lines 31-33; col. 135, lines 51-58; col. 137, lines 47-50; col. 169, lines 61-67); and
 - a decoder (see col. 42, lines 40-41; col. 126, lines 25-39) that decodes the encrypted contents using the extracted first key data (see col. 42, lines 40-41; col. 126, lines 25-39; col. 134, lines 31-33; col. 135, lines 51-58; col. 137, lines 47-50; col. 169, lines 61-67).

36. While Ginter discloses storing of the contract information associated with the advertisement as described above, Ginter does not specifically disclose storing of the

Art Unit: 3685

contract information upon viewing of the advertisement. Coffin, however, discloses a system and method for storing contract information, e.g. rewards, once a viewer watches an advertisement (see ¶0010; ¶0011). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of storing contract information upon viewing of the advertisement as disclosed in Coffin to Ginter in order to improve marketing effectiveness.

37. Per claim 36, Ginter further discloses a display wherein the display displays the content decoded in said decoder (see col. 9, lines 19-24; col. 255, lines 40-41).

38. Per claim 37, the claim is directed to using a second key that is stored in advance to encrypt/decrypt information and contract information. Ginter discloses various encryption techniques (see col. 206, line 56 – col. 228, line 25) including encryption protection of control information (see col. 15, lines 47-51).

39. Per claim 38, Ginter further discloses multiple encryption technique using multiple keys (see col. 208, lines 53-67). Ginter further discloses encrypting key blocks (see col. 135, lines 55-58; col. 136, lines 28-36).

40. Per claim 39 and 41, while Ginter discloses clock used to meter the usage (see col. 66, lines 48-56), Ginter does not specifically disclose deciding whether the advertisement is viewed completely. Coffin, however, discloses tracking actions of

Art Unit: 3685

viewer, e.g. whether the advertisement is viewed completely, in rewarding the viewer for viewing the advertisement (see ¶0010; ¶0011).

41. Per claim 40, Ginter further discloses multiple encryption technique using multiple keys (see col. 208, lines 53-67). Ginter further discloses encrypting key blocks (see col. 135, lines 55-58; col. 136, lines 28-36).

42. Per claim 42, Ginter further discloses copying of the contents and its control information wherein the copying, e.g. distribution is protected including no moves of the content (see col./line 326/50-327/67).

43. Per claim 43, Ginter discloses a viewing control method comprising:

- storing, in a storage, the contract information associated with the advertisement (see Fig. 7; Fig. 16; col. 10, lines 47-55; col./line 10/64-11/16; col. 18, lines 56-64; col. 19-58; col. 111, 25-41; col. 131, lines 7-27; col. 152, lines 10-16; col./line 272/62-273/39; col. 283, lines 52-53; col. 312, lines 31-32);
- searching, by a searcher, upon the information being acquired, for a same identification information as the identification information included in the acquired information from the identification information included in the contract information stored in the storage (see col. 23, lines 15-21; col. 68,

Art Unit: 3685

- lines 35-42; col. 110, lines 20-25; col. 111, 25-41; col. 131, lines 7-27; col. 167, lines 11-33);
- determining, by a decider, whether or not the viewing of the contents associated with the searched identification information is allowed, based on the date information included in the contract information including the searched identification information (see col. 49, lines 7-10; col./line 133/10-134/14; col./line 139/66-140/9; col. 155, lines 37-51; col. 169, lines 61-67; col./line 272/62-273/39);
 - extracting, by an extractor, upon a determination that the viewing is allowed, the first key data from the acquired information (see col. 134, lines 31-33; col. 135, lines 51-58; col. 137, lines 47-50; col. 169, lines 61-67); and
 - decoding, by a decoder, the encrypted contents using the extracted first key data (see col. 42, lines 40-41; col. 126, lines 25-39; col. 42, lines 40-41; col. 126, lines 25-39; col. 134, lines 31-33; col. 135, lines 51-58; col. 137, lines 47-50; col. 169, lines 61-67).

44. While Ginter discloses storing of the contract information associated with the advertisement as described above, Ginter does not specifically disclose storing of the contract information upon viewing of the advertisement. Coffin, however, discloses a system and method for storing contract information, e.g. rewards, once a viewer watches an advertisement (see ¶0010; ¶0011). It would have been obvious to one of ordinary skill in the art at the time of the invention to include the teachings of storing

Art Unit: 3685

contract information upon viewing of the advertisement as disclosed in Coffin to Ginter in order to improve marketing effectiveness.

Conclusion

45. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US Patent No. 5,794,210 discloses advertisement system and method; US Patent No. 5,629,980 disclose system and method for controlling usage of digital objects; US Patent Application No. 2002/0170053 discloses ECM and EMM distribution; US Patent Application No. 2003/0149665 discloses flexible content distribution system and method; US Patent Application No. 2003/0014310 discloses system and method for providing multimedia files combined with advertisements for providing the multimedia content free to the users.

46. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

47. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3685

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

48. Any inquiry concerning this communication or earlier communications from the examiner should be directed to STEVEN KIM whose telephone number is (571)270-5287. The examiner can normally be reached on Monday - Thursday (7:30AM - 5:00PM).

49. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571)272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

50. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/S. K./

Examiner, Art Unit 3685

Application/Control Number: 10/561,416

Page 17

Art Unit: 3685

/Calvin L Hewitt II/

Supervisory Patent Examiner, Art Unit 3685